

REMARKS/ARGUMENTS

The Applicants originally submitted Claims 1-20 in the Application. In a previous response, the Applicants canceled Claims 6 and 16 without prejudice or disclaimer and added Claims 21-22. In the present response, the Applicants have not amended, canceled, or added any claims. Accordingly, Claims 1-5, 7-15 and 17-22 are currently pending in the Application.

I. Rejection of Claims 1, 4-5, 8, 11, 14-15, 18 and 21-22 under 35 U.S.C. §103

The Examiner has rejected Claims 1, 4-5, 8, 11, 14-15, 18 and 21-22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0087650 by Aarnio (hereinafter "Aarnio") in view of U.S. Patent No. 7,266,186 to Henderson (hereinafter "Henderson") and further in view of U.S. Patent No. 6,594,503 to Herzig, *et al.* (hereinafter "Herzig"). The Applicants disagree for at least the reasons given below.

CITED PORTIONS OF HERZIG DO NOT TEACH A MOBILE TELEPHONE HAVING A CAMERA

At the top of page 4 of the Office Action, the Examiner states "Herzig teaches a mobile telephone 100 (Figs. 1 and 2) having a camera 110 or 120 (Figs. 1 and 2)..." Herzig teaches an apparatus and method to combine optical character recognition with a mobile phone. The mobile telephone 100 includes an optical character recognition reader 110 that can optically scan a printed telephone number and convert the scanned image (by the reader) into ASCII text that the mobile telephone can then use to dial the scanned telephone number. Figs. 1 and 2 describe a reader that includes an optical scanner 120 (to scan dial identification 102) and a processor 130 (to convert the scanned image into ASCII text). Fig. 2 also teaches that the mobile telephone 100 may not perform

the optical character recognition but a processor 140 in a base station 141 that the mobile telephone 100 is in contact with may perform the optical character recognition.

In either case, the reader 110 with optical scanner 120 is not a camera as claimed. Even the embodiments in Figs. 4-6 of Herzig do not teach the claimed camera. Instead, these embodiments teach a means to capture dial identification 102 that is 2 to 300 millimeters from the reader (embodiment in Fig. 4) or a means to capture dial identification 102 where a distance between the dial identification 102 and reader 110, D, is "substantially zero." (*See, e.g.*, lines 59-67 of column 3 and Fig. 5 of Herzig.) The claimed mobile telephone having a camera is not the OCR reader 110 of the embodiment of Figs. 1 and 2 of Herzig (relied upon by the Examiner) or the 'contact camera' of the embodiment of Figs. 4-6 of Herzig. Moreover, the OCR reader 110 or 'contact camera' of Herzig is not the camera of the cited portions of Aarnio.

Additionally, the Applicants contend that combining the OCR/'contact camera' of Herzig with Aarnio, as applied by the Examiner, would render Aarnio unsatisfactory for its intended use since Aarnio relies on a camera taking a picture of geographic location to enable identification of the location. If Aarnio used the OCR/'contact camera' of Herzig, it would not be able enable identification of a geographic location since the OCR/'contact camera' of Herzig can only focus on an image, as noted above, of less than 300 millimeters. MPEP §2143.01 states that "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As such, the cited portions of Herzig do not teach or suggest a mobile telephone having a camera and there is no suggestion or motivation to modify the cited portions of Aarnio with the cited portions of Herzig, as applied by the Examiner.

THERE IS NO MOTIVATION TO COMBINE AARNIO AND HERZIG AS THE EXAMINER SUGGESTS

At the middle of page 4 of the Office Action, the Examiner states:

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate a printed document as taught by Herzig into a user can easily make a call on the mobile telephone using the added extracted contact data as taught by Henderson into Aarnio's automated contact data in order to increase convenience for the user (Col. 1 lines 22-30).

The Applicants assume the Examiner intended to state that it would have been obvious to incorporate a printed document as taught by Herzig into 'a mobile telephone so that' a user can easily make a call on the mobile telephone using the added extracted contact data...to increase convenience for the user. As established above, modifying Aarnio with the teachings of Herzig renders Aarnio unsatisfactory for its intended use. If the Examiner is suggesting that it would have been obvious to one of ordinary skill in the art at the time of the invention to add the OCR/'contact camera' of Herzig to the phone of Aarnio, the Applicants respectfully disagree.

Adding the OCR/'contact camera' of Herzig to the phone of Aarnio would add cost and complexity to the phone of Aarnio. As such, this would provide a disincentive to one of ordinary skill in the art at the time of the invention to make the combination the Examiner suggests. Additionally, one of ordinary skill in the art at the time of the invention would not be motivated to combine the teachings of Aarnio and Herzig because Aarnio and Herzig solve different problems.

Aarnio solves the problem of identifying a geographic location based on an image and a receipt of a Location Area Identity (LAI). (*See, e.g.*, paragraphs [0017]-[0018] of Aarnio.) Herzig solves a totally different problem of dialing a mobile phone automatically from a printed phone number. (*See, e.g.*, lines 22-30 of column 1 of Herzig.) The Board of Patent Appeals and Interferences has stated recently:

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) cited with approval in KSR)

The Applicants contend that the reasoning the Examiner has given for motivation to combine the teachings of Aarnio and Herzig - that it increases convenience for the user - is conclusory. Increasing the convenience for a user of a mobile telephone can be said for many features, but that does not necessarily provide motivation to incorporate those features. The Applicants fail to find any articulated reasoning with some rational underpinning given by the Examiner to support the legal conclusion of obviousness to combine the teachings of Aarnio and Herzig as applied by the Examiner. On the contrary, the Applicants contend that there is no reason one of ordinary skill in the art at the time of the invention would be motivated to add the automatic dialing features of Herzig to the geographic location identifying phone of Aarnio since doing so would NOT improve the ability of the phone of Aarnio to solve the problem it is intended to solve, namely identify a geographic location of the phone. Further, the Applicants contend that there is motivation to NOT include the feature Herzig in the phone of Aarnio as doing so would increase cost and complexity of the phone of Aarnio.

CONCLUSION

For at least the reasons given above, the cited combination of Aarnio, Henderson, and Herzig, as applied by the Examiner, does not provided a *prima facie* case of obviousness for pending independent Claims 1 and 11 and Claims that depend thereon. Accordingly, the Applicants respectfully request the Examiner to withdraw the §103(a) rejection of Claims 1, 4-5, 8, 11, 14-15, 18 and 21-22 and allow issuance thereof.

II. Rejection of Claims 2-3, 7, 9-10, 12-13, 17, and 19-20 under 35 U.S.C. §103

The Examiner has rejected Claims 2-3, 7, 9-10, 12-13, 17, and 19-20 under 35 U.S.C. §103(a) as being unpatentable over Aarnio in view of Henderson and further in view of Herzig and further in view of: U.S. Patent No. 6,956,833 to Yukie, *et al.* (hereinafter "Yukie") for Claims 2, 7, 9, 12, 17, and 19; U.S. Patent Application Publication No. 2003/0211856 by Zilliacus (hereinafter "Zilliacus") for Claims 3 and 13; and U.S. Patent Application Publication No. 2003/0181200 by Iida (hereinafter "Iida") for Claims 10 and 20. The Applicants respectfully disagree.

As established above, the cited portions of the cited combination of Aarnio, Henderson, and Herzig, as applied by the Examiner, does not provide a *prima facie* case of obviousness for pending independent Claims 1 and 11 and Claims that depend thereon. Yukie, Zilliacus, and Iida have not been cited to cure the above-noted deficiencies of the cited portions of the cited combination of Aarnio, Henderson, and Iida, but to teach the subject matter of the above-mentioned dependent claims. As such, pending independent Claim 1 and 11 and Claims that depend thereon are not obvious over Aarnio, Henderson, and Herzig alone, or in combination with Yukie, Zilliacus, or Iida.

Accordingly, the Applicants respectfully request the Examiner to withdraw the §103(a) rejection of Claims 2-3, 7, 9-10, 12-13, 17, and 19-20 and allow issuance thereof.

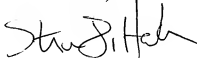
III. Conclusion

In view of the foregoing remarks, the Applicants now see all of the Claims currently pending in this Application to be in condition for allowance and therefore earnestly solicit a Notice of Allowance for Claims 1-5, 7-15 and 17-22.

The Applicants request the Examiner to telephone the undersigned agent of record at (972) 480-8800 if such would further or expedite the prosecution of the present Application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

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